

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Bell et al.	Art Unit :	1773
Serial No. :	10/700,970	Examiner :	Leszek B. Kiliman
Filed :	November 4, 2003	Conf. No. :	4489
Title :	EMBOLIC COMPOSITIONS		

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REVIEW REQUEST

Pursuant to United States Patent and Trademark Office OG Notices: 12 July 2005 - New Pre-Appeal Brief Conference Pilot Program, a request for a review of identified matters on appeal is hereby submitted with the Notice of Appeal. Review of these identified matters by a panel of examiners is requested because the rejections of record are clearly not proper and are without basis, in view of a clear legal or factual deficiency in the rejections. All rights to address additional matters on appeal in any subsequent appeal brief are hereby reserved.

Remarks

Claims 1-14 and 16-31 are pending, with claims 3-5, 7, 9-13, 17, and 25-31 being withdrawn from consideration.

In the Office Action mailed April 17, 2007, the Examiner provisionally rejected claims 1, 2, 6, 8, 14, 16, and 18-24 under the judicially created doctrine of obviousness-type double patenting in view of claims 1-37 of copending USSN 10/791,103. However, this rejection seems inappropriate. In the present application, the Examiner issued a Restriction Requirement¹ in which a spherical shape (claim 3) was stated as being a patentably distinct species from a particle having a shape that is substantially free of a concave region (claim 2). (See, e.g., the Restriction Requirement at p. 4.) Applicants elected the latter species, and claim 3 remains withdrawn from consideration. Thus, it is inconsistent for the Examiner to now reject, for example, claim 2 under the judicially created doctrine of obviousness-type double patent based on the claims 1-37 in

¹ The Restriction Requirement was mailed February 7, 2006.

USSN 10/791,103 when these claims require generally spherical particles. Applicants therefore request reconsideration and withdrawal of this rejection.

Alternatively, if the Examiner re-enters non-elected claims 3-5, 7 and 17, which Applicants believe he should because these claims were withdrawn based on a species election and the generic, linking claim (claim 1) is rejected solely on the basis of an obviousness-type double patenting rejection, then Applicants will submit a terminal disclaimer relative to claims 1-37 in USSN 10/791,103, thereby obviating what would be the sole outstanding rejection.

Payment for the Notice of Appeal is enclosed. No additional fees are believed to be due in connection with the filing of this request for review. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: July 24, 2007

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